

**REMARKS/ARGUMENTS**

Claims 25-31 and 45-65 are pending. By this Amendment, claims 25-30 are amended and claims 61-65 are added. Reconsideration and withdrawal of the rejection are respectfully requested.

The Abstract has been replaced to remove so-called “legal phraseology”.

On page 2 of the Office Action, claims 45-60 are withdrawn by “original presentation”, since the new claims recite a “side wall”. This restriction is clearly improper as the original restriction did not distinguish the claim groupings on this basis. The Species I claims were merely broken out as directed to a “mask pad”. As all of claims 45-60 recite such mask pad, they are by definition directed to the elected group. Moreover, the Examiner has not established that the claims are restrictable simply by their recitation of a side wall. In order to make the restriction moot, claims 25, 28 and 29 now recite a side wall – the alternative is to remove such from claims 45-60. Thus, claims 45-60 should be examined on their merits.

Claims 1, 3-12, 26-29 and 31-36 are rejected under 35 USC §102(b) over Lang et al. (EP 1 099 452). This rejection is respectfully traversed.

At the outset, it is noted that the Office Action points to several embodiments within the disclosure of Lang et al. in order to support the rejection. For example, in regard to the rejection of independent claims 1 (canceled), 26 and 29, the Examiner points to Figures 1a and 1e, as well as Figure 7 of Lang et al. to support the rejection. Thus, it appears that the Examiner is attempting to combine various embodiments to reject the claim, but the Examiner has not resolved the differences between the claims and the Figure 1a/1e embodiment, and has not providing any reason why one of ordinary skill in the art would have combined the Figure 1a/1e embodiment with the embodiment of Figure 7. Thus, the examiner simply picks and chooses

various elements of two distinct embodiments in order to reject the claims. It should be noted that the Examiner's attempt to combine different embodiments in the same reference is no different than an attempt to combine two different references. The Examiner's apparent position that the two embodiments when taken together constitute a valid rejection based on anticipation is clearly erroneous.

In response to this argument, the Examiner takes the position that the structure of Figures 1a, 1c and 7 are taught to be combinable together in paragraphs [0022], [0029] and [0030] of Lang et al. However, these paragraphs reveal no such indication.

Even if it would have been obvious to have made the combination, which Applicants do not concede, Lang et al. does not teach that the zone of thickened cross-section includes a gel-like crosslinked elastomer body inserted into a fixing structure provided in the internal space of the mask. The Examiner apparently disregarded the original language from the claim as directed to a product-by-process. This interpretation is respectfully traversed and in any event is obviated by the clarifying amendment to claim 26 herein, which even more particularly requires the Examiner to consider the recited features. This argument is not addressed in the Final Rejection.

In regard to claim 29, Lang et al. does not disclose either that 1) provided in the mask pad is at least one closed receiving pocket portion and 2) provided in said receiving pocket portion is a cushion body comprising a gel material. Lang et al.'s element 34 is not a closed pocket, and paragraph [0041] does not disclose a gel. In response, the Examiner points to an overly broad definition of "closed" and does not address the second argument – that Lang et al. does not disclose a gel as claimed.

In regard to independent claim 31, Lang et al. do not disclose a forehead pad for a breathing mask comprising a forehead pad base body which is made from an elastomer material

and has a coupling portion for fixing the forehead pad to a forehead support device and a stem portion for radially yieldingly mounting a forehead contact portion provided for bearing against a forehead surface, wherein the forehead pad has a zone of thickened cross-section and in said zone is provided with a gel or foam material. Lang et al. does not disclose a forehead pad, or a stem, of that the forehead pad has a zone of thickened cross section which is provided with a gel or foam. Lang et al. discloses a nose/mouth cushion, not a forehead pad. There is no reason to believe that Lang et al.'s nose/mouth cushion is capable of being a forehead pad.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 2 and 30 were rejected under 35 USC §103(a) over Lang et al. in view of US 2009/0178679 to Lithgow et al. However, this rejection is respectfully traversed as Lithgow et al. qualifies under 35 USC §102(c) and Lithgow et al. is commonly owned with Lang et al., thus making it ineligible for combination with Lang et al under Section 103(a), per MPEP 706.02(k). As Lithgow et al. clearly indicates on its face that it is assigned to ResMed, the Examiner's position on page 5 of the Final Rejection is improper.

Claim 25 was rejected under 35 USC §103(a) over Lang et al. in view of Le Mitouard (US 5,429,683). This rejection is respectfully traversed.

Claim 25 specifies a sealing lip of an elastomer material and a thickened section having a foam cushion. The Lang et al./Le Mitouard combination does not teach this subject matter. Lang et al. teaches a combined elastic material and gel-like material. Any motivation to combine Lang et al. with Le Mitouard would result in a cushion having a foam (only) construction, not an elastomer and a foam combined, as Le Mitouard emphasizes that the foam lining includes a tubular end piece 8 that engages with the shell – this at best suggests to replace Lang et al.'s entire sealing structure, not just parts thereof, with a foam. There is simply no reason why one of

ordinary skill in the art would have substituted the gel-like material in Lang et al. Figure 7 with a foam. This argument is not addressed in the Final Rejection.

Reconsideration and withdrawal of the rejection are respectfully requested.

New claims 61- 65 are presented for the Examiner's consideration.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140 under Order No. PTB-4750-23.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:                     /Paul T. Bowen/                      
Paul T. Bowen  
Reg. No. 38,009

PTB  
Attachment:  
Replacement Abstract of the Disclosure

901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100